

2498/101

APPENDIX B**Summary of Telephone Interview of November 6, 2003 with
Examiner Peter Paras regarding
U.S. Application No. 09/472,558 to Bahramian et al.**

Examiner Paras telephoned Barbara Carter on November 5, 2003 indicating that there may be some claims allowable, but advised that new prior art to Fire et al. had been found. Although it was not Examiner Paras's intention to have a discussion of the Fire et al. reference, he thought we should be aware of it and that it may anticipate even the DNA claims. Ms. Carter expressed appreciation for the courtesy of the telephone call, and requested time to to at least preliminarily review the Fire et al. reference and contact the inventors to inform them of the possible allowable claims and the Fire et al. reference. Ms. Carter called Examiner Paras back on November 6, 2003 after speaking briefly with one of the inventors, and a discussion took place regarding which claims, with which specific limitations, were considered allowable by Examiner Paras. Ms. Carter inquired which specific claims were allowable; Examiner Paras was not able to point to a claim, as written, that was allowable, but thought we could get to one. Ms. Carter asked whether the allowable independent claim would be limited to DNA, RNA, or both; Examiner Paras said he wasn't sure, but thought it would probably be DNA, based on Fire, although Fire et al. may also disclose DNA. Ms. Carter asked which genes would be covered in the allowable independent claim; Examiner Paras stated he was not sure, but was not ready to agree to the list which included a collagen, a *tat*, a TNF or an immunoglobulin gene, stating that the immunoglobulin genes included a huge class of genes. Ms. Carter inquired whether the allowable claim would cover all animals; Examiner Paras said he was not sure, but thought it would probably have to be only rodents. At this point, Ms. Carter said she could not possibly agree on a claim limited to only rodents, collagen, and DNA, if that was where Examiner Paras was going, because she and her clients had not had time to fully review the Fire et al. reference, because Examiner Paras was not totally sure of the impact of the Fire et al. reference on the pending claims, and because she and her clients felt strongly that the application had support for more genes than just collagen and for more animals than just rodents so it would be irresponsible to agree to a claim with limited scope if her clients were entitled to broader coverage.

Examiner Paras agreed that we were not really in a position to agree on an allowable independent claim, but also agreed that after fully reviewing Fire et al., and any other reference he may find in the meantime, he would indicate which subject matter/claims might be allowable in the subsequent office action. Ms. Carter thanked him for his efforts, and for the courtesy of the telephone call, and his willingness to identify allowable subject in the next office action. No agreement was reached regarding an allowable claim.